

*Art-Related Remarks*

35 U.S.C. § 102

Applicants respectfully traverse the rejection of claims 79-83 under 35 U.S.C. § 102(b) as allegedly being anticipated by Bodor *et al.*, (Clinical Chemistry, 1992).

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). *See also, In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143.

Applicant first respectfully notes that the Examiner has withdrawn an equivalent rejection of claims 69-74 over the same Bodor *et al.* publication in light of Applicants' previous arguments. Paper No. 12, page 2. Because the arguments that successfully overcame the rejection with regard to claims 69-74 are equally applicable to the present rejection, Applicants repeat these arguments below.

The instant claims relate to one or more antibodies immobilized on a solid phase that specifically bind to each of the following: free cardiac specific troponin I, binary complexes comprising cardiac specific troponin I, and ternary complexes comprising cardiac specific troponin I (claims 79, 80, 82, 84, and 86); to methods of selecting such antibodies (claims 81, 83, 85, and 87); to compositions comprising a first antibody on a solid phase, and a second antibody conjugated to a signal generating element, each of which specifically bind to free cardiac specific troponin I, binary complexes comprising cardiac specific troponin I, and ternary complexes comprising cardiac specific troponin I (claims 88-90); and to methods of selecting antibodies for use in sandwich immunoassays that specifically bind to free cardiac specific troponin I, binary complexes comprising cardiac specific troponin I, and ternary complexes comprising cardiac specific troponin I (claims 91-93).

In contrast, the Bodor *et al.* publication discloses eight monoclonal antibodies, five of which bind cardiac troponin I, and three of which react with both cardiac and skeletal troponin I. See, Bodor *et al.*, page 2212, column 1. The Bodor *et al.* publication, however, does not disclose any antibody that binds to cardiac troponin I in a ternary complex with troponin C and troponin T, or any antibodies that are insensitive with respect to all the recited troponin I forms.

To the extent that the Examiner contends that the claimed functional result would be an inherent property of the Bodor *et al.* publication, Applicants respectfully note that the mere fact that such a characteristic may occur is not sufficient to establish inherency. Rather, the Examiner must establish that the characteristic necessarily occurs. See, e.g., MPEP §2112. Applicants note that an antibody that is capable of binding to free troponin I, for example, may be blocked from binding when troponin I is present in a ternary complex; thus, the Bodor *et al.* publication does not necessarily disclose any antibodies that meet the limitations of the instant claims. Should the Examiner disagree, Applicants respectfully request that the Examiner provide extrinsic evidence making it clear that the missing descriptive matter from the claims is necessarily present in the devices disclosed in the Bodor *et al.* publication.

Because the Bodor *et al.* publication does not teach or suggest each and every element of the instant claims, no *prima facie* case of anticipation has been established. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

### CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that the pending claims are in condition for allowance. An early notice to that effect is earnestly solicited. Should any matters remain outstanding, the Examiner is encouraged to contact the undersigned at the address and telephone number listed below so that they may be resolved without the need for additional action and response thereto.

Respectfully submitted,  
FOLEY & LARDNER

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